

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 1-11, 13-19, and 21-42 will be pending, claims 1, 6, 7, 13, 38, and 40 being independent.

Summary of the Office Action

Claims 5, 11, 19, 21, 22, 26, 27, 31, and 32 are indicated as containing allowable subject matter, although they are objected to for depending upon rejected claims.

Claims 24, 25, 29, and 30 are rejected under 35 USC §112, first paragraph, as allegedly containing subject matter of which Applicants were not in possession at the time the application was filed, *i.e.*, for non-compliance with the written description requirement of §112, first paragraph.

Claims 1-4, 7-10, 13-18, 23-25, and 28-30 are rejected under 35 USC §103(a) as being unpatentable over KELLER et al. (U.S. Patent No. 5,909,893, hereinafter "KELLER") in view of TANAKA (U.S. Patent No. 6,386,574) and VITALI et al. (U.S. Patent No. 5,380,031, hereinafter "VITALI").

Response to the Office Action**A. Withdrawal of Rejection Under 35 USC §112, First Paragraph**

Applicants respectfully traverse the Examiner's rejection of claims 24, 25, 29, and 30 under 35 USC §112, first paragraph.

The rejection is based upon the allegation that "Paragraph 0038 in the specification limits the range to between 0.1 mm and 1.0 mm. However, the claims extend the range to 3.0 mm."

On page 0060 of the specification as originally filed, Applicants have specified, with regard to an exemplary embodiment, that "The plate 120 can be made of plastic or metallic material whose thickness can be comprised between 0.5 mm and 3.0 mm, or approximately therebetween."

Accordingly, Applicants had possession of the subject matter of the rejected claims (which call for "a thickness approximately within a range of between 0.5 mm and 3.0 mm") at the time the application was filed and, therefore, withdrawal of the rejection is requested.

The statement in paragraph 0038, cited in the rejection, relates to an exemplary embodiment and fails to limit the invention to a thickness of 0.1 mm and 1.0 mm. In fact, the paragraph calls for "a thickness comprised *preferably* between 0.1 mm and 1.0 mm, or approximately within the range of 0.1 mm and 1.0 mm." (emphasis added)

B. Withdrawal of Rejection Under 35 USC §103(a)

Applicant requests that the rejection under 35 USC §103(a) based upon a combination of KELLER and TANAKA and VITALI be withdrawn.

1. A Single Plate

Each of Applicants' claims 1, 6, 7, and 13 include the limitation that the assembly of the invention includes a "single plate." None of KELLER, TANAKA, and VITALI disclose a boot retaining assembly that includes a single plate.

In contrast, KELLER provides a first pair of screws 8 that extend through a pair of holes in a first plate 12 and a second pair of screws 8 that extend through a pair of holes in a second plate. *Each of the screws 8 of KELLER's disclosed retaining apparatus do not extend through a single plate.* Further, neither TANAKA nor VITALI provides a teaching or suggestion to supply this deficiency of KELLER.

As Applicants have explained previously, according to the invention, by virtue of having all of the screws extending through a single plate, the user can position all of the screws for mounting the retention assembly upon a sports apparatus, such as a snowboard, in a single manipulation. As a result, the mounting and adjusting operations are less time-consuming and simpler and the positioning of the retention assembly on the board is easier. None of VITALI, TANAKA, and KELLER teach or suggest this.

On page 6 of the Office action of May 16, 2003, the Examiner comments that despite KELLER's provision of a *second* plate, Applicants' recitation of a *single* plate "fails to distinguish over the prior art."

Applicants respectfully disagree.

More specifically, Applicants submit that the rejection is based upon an interpretation of the word "single" that is contrary to the ordinary and customary meaning of the word.

As explained in *Tate Access Floors, Inc. v. Maxcess Techs*, 55 USPQ2D 1513 (Fed. Cir. 2000), which is exemplary of a number of somewhat recent decisions from the Court of Appeals for the Federal Circuit, terms in a claim are to be given their ordinary and customary meaning unless there is an express intent to impart a novel meaning to such terms.

In *The American Heritage Dictionary of the English Language*, Fourth Ed., Houghton Mifflin Co., Boston, Mass., 2000, the first definition of the word "single" (on page 1625) is "Not accompanied by another or others; solitary."

In KELLER, neither of the plates 12 comprises a "single" plate of the disclosed retaining apparatus when the term "single" is accorded its ordinary and customary meaning. Further, there would have been no reason to one skilled in the art to either modify the apparatus of KELLER, or to do without one of the two plates 12, except for the purpose of rejecting Applicants' claims.

Further to the foregoing, in addition to each of claims 7 and 13 including the limitation of "a single plate", claims 7 and 13 include the limitation "all of the at least two screws extending through respective ones of the holes of the plate" Not only do none of KELLER, TANAKA, and VITALI teach or suggest an assembly in which all screws are positioned in a single plate, none teach or suggest all of the screws extending through the holes of such single plate. As Applicants have explained, this feature provides for an ease of assembly to the sports

apparatus, whereby a single manipulation can accurately position the screws to their intended positions.

2. Retaining Means

The end of Applicants' claims 1 and 6 call for "means for retaining the screws on the plate."

This limitation is addressed in the rejection by directing attention to the newly cited VITALI patent.

In this regard, Applicants note that the rejection includes an acknowledgement that KELLER does not disclose a retaining means for retaining the screws on the plate and that a secondary teaching is required, *viz.*, VITALI.

Regarding TANAKA, which is relied upon for its teaching of a base, Applicants submit that KELLER appears to disclose a base 9 (column 9, lines 23-27).

VITALI discloses a device for assembling an accessory, such as the base of a binding, upon a ski and, more specifically, a device that includes an arrangement by which screws are held in their holes when the base is placed on the ski.

Of course, in VITALI no slidable plate is disclosed and there is no need to move the screws in position along elongated holes relative to the base. Further, in VITALI, there is no disk having such elongated holes.

First of all, regarding the proposed combination of KELLER and VITALI, Applicants submit that it would not be clear to one skilled in the art how either of the thin plates 12 of KELLER could be modified to incorporate the structures taught by VITALI for the purpose of holding KELLER's screws relative to the plates 12.

However, even if one were able to utilize the teachings of VITALI in the apparatus of KELLER, one would have screws that are held in the holes of the plates 12, but one would *not* be able to realize the objective of VITALI, *viz.*, holding screws relative to the base as the base

is placed upon the ski. That is, the plates 12 would be free to become loose relative to the fastening plate 1 upon which the plates 12 are supported.

Consequently, Applicants submit that any suggestion for modifying KELLER's apparatus by means of the teachings of VITALI can only originate improperly with Applicants' disclosure.

In addition to VITALI, Applicants are concurrently filing an information disclosure statement citing U.S. Patent No. 3,917,300, which is directed to another structure for holding screws preparatory to screwing a binding to a ski. However, Applicants submit that one skilled in the art would not have been led to Applicants' invention from the teachings of US '300.

3. Plate on Lower Portion of Disk

In a number of dependent claims (claims 2, 8, 15, 33, and 34, *e.g.*), Applicants call for the plate to be located on a lower portion of the disk, or in a cavity in the lower surface of the base or disk. In the first complete paragraph on page 6 of the Office action, it is explained that this orientation (presumably modified from that disclosed by KELLER) "represents an obvious reversal of parts."

Applicants respectfully disagree.

If one were to rearrange the relationship between the plates 12 of KELLER and his plate 1, use of the KELLER apparatus would be hampered and, accordingly, one skilled in the art would *not* have contemplated such reversal for this reason.

Specifically, as explained in column 4, lines 30-50 of KELLER, the plates 12 include arcuate recesses 14 in their longitudinal sides. Therefore, if the screws were to use the holes 7 rather than the holes in the plates 12, the plates could be positioned so that the arcuate recesses 14 would be aligned with the holes 7. If, however, one were to reverse the positions of the plates, so that the plates were to be *beneath* the plate 1, the arcuate recesses 14 would be blocked from view and their alignment with the holes 7 would not be facilitated.

At least for the reasons given above, Applicants submit that all of the previously presented claims should be allowed.

C. New Claims

In the amendment above, Applicants have added new claims 33-42, all of which claims 38 and 40 are independent.

Claims 33 and 34 include the limitation relating to the position of the plate in a cavity recessed in the lower surface of the disk and base, respectively, of claims 1 and 13.

Claims 35, 36, and 37 emphasize that there is but a single plate in these claims. Specifically, these claims refer to the single plate as being "the only plate of the retaining assembly" having a particular size and shape. Of course KELLER's apparatus includes *two* plates having the same size and shape.

Independent claim 38 calls for "a plurality of screws, each of said screws having a single predeterminate size and shape to extend through a respective one of said elongated holes of said base, through a respective one of said holes of said plate, and into an upper surface of the sports apparatus to secure said base onto the sports apparatus;" and "said plurality of screws comprising means for retaining said plate connected to said base when said plurality of screws are not screwed into the sports apparatus."

Claim 38, therefore, is directed to the embodiment of the invention shown, e.g., in Figs. 1 and 2, whereby even before the apparatus is secured to the sporting apparatus (snowboard 2, e.g.), the plate 50 remains connected to the base (via the disk 20 of the base, e.g.) because of the screws. No teaching or suggestion is provided by any of the documents of record for this embodiment.

Claim 39 depends from independent claim 39 and adds that the base includes a disk, with the elongated holes extending through the disk of the base.

Independent claim 40 specifies that the base can be positioned in either an assembled position, relative to the sports apparatus, or a disassembled position, whereby, "in said assembled position of the retaining assembly, every screw extending into the upper surface of the sports apparatus extends through said plate of the assembly." Claim 40 also calls for the plate to be the "one and only plate of the assembly" having a particular size and shape.

Dependent claim 41 is directed to the aforementioned feature of claim 38, whereby the plurality of screws "comprise means for retaining said plate connected to said base when said plurality of screws are not screwed into the sports apparatus."

Lastly, like claim 39, claim 42 adds to the invention of claim 41 that the base includes a disk, with the elongated holes extending through the disk of the base.

D. Pending Claims are Not all Directed to the Final Assembly

Near the top of page 7 of the Office action is a sentence declaring that "[t]he pending claims, and all claims presented to date, have been directed to the final assembly and not various stages of the assembly process.

This is not true. The final assembly would have the retaining assembly secured to the sports apparatus, such as a snowboard. Applicants' claims do not require such final assembly. In fact, the claims encompass assemblies in which the various components of which the assemblies are comprised can be sold as a distinct assembly that can be used by a purchaser, or a retailer, to be affixed to a sports apparatus such as a snowboard.

SUMMARY AND CONCLUSION

The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is enclosed for payment of claim fees. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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